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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,524	08/09/2000	Hiroyuki Takahashi	P19483	5635

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EXAMINER
LEE, CHRISTOPHER E

ART UNIT	PAPER NUMBER
2189	7

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,524

Applicant(s)

TAKAHASHI, HIROYUKI

Examiner

Christopher E. Lee

Art Unit

2189

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 08 September 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt Acknowledgement

1. Receipt is acknowledged of the Amendment filed on 8th of September 2003. Claims 1-7 have been amended; claim 8 has been canceled; and no claim has been newly added since the last Office Action was mailed on 9th of April 2003. Currently, claims 1-7 are pending in this application.

Claim Objections

2. Claims 2-7 are objected to because of the following informalities:

Substitute "A microcomputer" in line 1 of the claims 2-7 by --the microcomputer--, respectively.

In the claim 2, it recites the subject matter "an address-coincidence-disabling system" in line 4. However, the same subject matter has been defined in the parent claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for scrapping return-address, temporarily stored in the stack memory area of the RAM, without being restored into the program counter, and jumping to the instruction for calling the next subroutine (See Application, page 70, lines 1-15, and Fig. 31, steps J3 and J4), does not reasonably provide enablement for setting the comparison address data (i.e., address data of the defective part in the ROM) as a return-address data in the program counter when the interruption-processing is completed (See claim 1). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Furthermore, the claim 1 recites the limitation "an address-coincidence-disabling system that disables the

coincidence between said comparison address data and said return-address set in said program counter by said return-address-setter”, which causes that the claimed invention cannot achieve the objective of the applicant’s invention, such that the objection of the applicant’s invention is to provide a microcomputer with a program-revision ability, wherein a revision can be made in an optional location of programs stored in a ROM thereof (See Application, page 4, line 23 through page 5, line 1), because said controller/calculator (i.e., CPU) would fetch and execute the defective part of ROM after completion of the revision execution, i.e., the program counter has been set said comparison address data (i.e., address data of the defective part in ROM) as the return address of the interrupt-processing when the interruption-processing has been completed (See claim 1). The claims 2-7 are dependent claims of the claim 1.

Response to Arguments

5. Applicant's arguments filed on 8th of September 2003 have been fully considered but they are not persuasive.

In response to the Applicant’s argument with respect to “the specification is sufficiently enabling with respect to the subject matter of amended claim 1” on the Response, pages 7-9, the Examiner respectfully disagrees.

The Applicant states that the return-address, temporarily stored in the stack memory area of the RAM, is scrapped without being returned to the program counter (See Application, page 70, lines 1-4), and restored into the program counter, and jumping to the instruction for calling the next subroutine (See Application, page 70, lines 1-15, and Fig. 31, steps J3 and J4). In other words, the defected part in the ROM is skipped over, and the program counter is pointing out the instruction for calling the next subroutine, which is under a good condition in the ROM.

However, the Applicant’s disclosure does not reasonably provide enablement for the scope of the claimed invention, such that setting the comparison address data (i.e., address data of the defective part in the ROM) as a return-address data in the program counter when the interruption-processing is completed (See

claim 1, lines 23-25) because the comparison address data has been clearly defined as an address data of the program in the ROM, which is to be virtually revised by a revisional program in the RAM (See claim 1, lines 7-12), then a return-address-setter sets return-address data in the program counter to coincide with the comparison address data (i.e., address data of the program in the ROM) when execution of the interruption-process in accordance with the revisional program is completed (i.e., after the completion of revisional program execution, the program in the ROM, which has been revised by the revisional program in the RAM, is run by the controller/calculator based on the program counter, instead of skipping over the revised program in the ROM; See claim 1, lines 23-25).

Furthermore, the Applicant recites the limitation "an address-coincidence-disabling system that disables the coincidence between said comparison address data and said return-address set in said program counter by said return-address-setter" (See claim 1, lines 26-28), which causes that the claimed invention cannot achieve the objective of the applicant's invention, such that the objection of the applicant's invention is to provide a microcomputer with a program-revision ability, wherein a revision can be made in an optional location of programs stored in a ROM thereof (See Application, page 4, line 23 through page 5, line 1), because said controller/calculator (i.e., CPU) would fetch and execute the defective part of ROM after completion of the revision execution, i.e., the program counter has been set said comparison address data (i.e., address data of the defective part in ROM) as the return address of the interrupt-processing when the interruption-processing has been completed (See claim 1, lines 23-25).

Even though the specification is sufficiently enabling with respect to the Applicant's invention based on the text disclosure, pages 47-48 and page 70, lines 1-15, it does not reasonably provide enablement of the scope of the Applicant's claimed invention, especially the subject matters in the amended claim 1. Thus, the Applicant's argument on this point is not persuasive.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E. Lee whose telephone number is 703-305-5950. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on 703-305-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Christopher E. Lee
Examiner
Art Unit 2189

cel/


SUMATI LEFKOWITZ
PRIMARY EXAMINER